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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,884	09/23/2003	Edward G. Sutt JR.	011988-0304484	8627

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EXAMINER

BUI, LUAN KIM

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/667,884	SUTT, EDWARD G.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Luan K Bui	3728	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/20/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

***Specification***

Applicant is required to update the current status of the parent applications as indicated in the cross reference to related applications on page 1 of the instant patent application.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 9, 10, 12, 21, 24, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shelton (4,836,372) in view of the "Standard Specification for Driven Fasteners: Nails, Spikes, and Staples, American Society for Testing and Materials," (hereinafter ASTM). Shelton discloses a package (10) of collated nails comprising a plurality of nails (12) with each nail having a length including a substantially round head (14) having a head diameter, a flat top surface and a bottom surface, an elongate shank (16) having a shank diameter, a point opposite the head and a plurality of surface deformations (50, 56) formed on the shank having a plurality of longitudinally spaced apart rings and at least one attachment structure (32) constructed to temporarily attached the plurality of nails into a package. Shelton also discloses the other limitations of the claims except for the shank diameter between 0.092 to .148 inches, the length between 1.625 inches and 3.00 inches and the ratio of the head diameter to shank diameter of each nail being between 2.70 and 3.37. ASTM shows various sizes of nails in Table

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36 including a nail having a length of 1.75 inches, a shank diameter of 0.113 inches and a head diameter of 0.312 inches. ASTM shows each nail having the ratio of the head diameter to the shank diameter is about 2.76. It would have been obvious to one having ordinary skill in the art at the time the invention was made in view of ASTM to modify the nails of Shelton so the shank diameter of each nail generally corresponds to a shank diameter as specified by ASTM F1667 comprises the shank diameter between 0.092 to .148 inches, the length between 1.625 inches and 3.00 inches and the ratio of the head diameter to shank diameter of each nail being between 2.70 and 3.37 to provide more standardize nail package for various applications. As to claim 10, Table 36 of ASTM shows the head diameter and the shank diameter remain unchanged when the length changes from 1.25 to 1.75 inches. With the head diameter and the shank diameter remain unchanged, the ratio of the head diameter to shank diameter is about 2.76 which is considered equivalent to "approximately 2.83" as claimed. As to claim 12, it would have been obvious to one having ordinary skill in the art in view of Shelton as modified to increase the length of the nails to approximately 2 or 2.25 or 2.5 inches to provide more convenience for the user in a specific application and also for better securing the nails to the panel. The nails of Shelton as modified are capable for pallet securement.

3. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 2 above, and further in view of Leistner (5,909,993). The package of Shelton further fails to show the attachment structure comprises a pair of parallel frangible wires welded to the shank of each nail. Leistner shows a package of collated nails comprising a plurality of nails (17) and an attachment structure (64, 66, W) including a pair of parallel

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frangible wires welded to the shank of each nail to temporary attach the plurality of nails into a package. It would have been obvious to one having ordinary skill in the art in view of Leistner to modify the package of Shelton so the attachment structure comprises a pair of parallel frangible wires welded to the shank of each nail for better securing the nails together.

4. Claims 5-8, 11, 22, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 2 above, and further in view of Colechia (4,002,098).

The package of Shelton as modified further fails to show each nail comprises a plurality of spiral flutes. Colechia teaches a package of a plurality of nails (10) and each nail having a spiral fluted configuration or the like (column 4, lines 64-68). It would have been obvious to one having ordinary skill in the art in view of Colechia to modify the nails of Shelton as modified so each nails comprises a plurality of spiral flutes for better holding items together in a certain application.

5. Claims 13-20 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Ginnow (5,673,629). The package of Shelton as modified further fails to show a pallet comprises a plurality of spaced bottom wooden boards, a plurality of spaced middle wooden boards and a plurality of top wooden boards and the nails for securing the plurality of boards together to form a pallet. Ginnow teaches a wooden pallet (21) comprising a plurality of spaced bottom wooden boards (23), a plurality of spaced middle wooden boards (20) and a plurality of top wooden boards (23) and a plurality of nails (34) for securing the plurality of boards together to form a pallet. It

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would have been obvious to one having ordinary skill in the art in view of Ginnow to modify the package of Shelton so the plurality of nails are used for securing a plurality of boards together to form a wooden pallet for better supporting articles on the pallet. Claims 28-29 are drawn to the obvious method of using the package of Shelton as modified for securing the plurality of boards together to form the pallet as above.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3, 9, 10, 12, 21, 24, 25 and 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,758,018. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structural limitations in the claims of the instant patent application are fully disclosed by the Patent No. 6,758,018 except for the intended use. Regarding the intended use of the claimed invention for pallet wooden board securement, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed

structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

8. Claims 1-3, 9, 10, 12, 21, 24, 25 and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending application Serial No. 10/060,411. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structural limitations in the claims of the instant patent application are fully disclosed by the copending application except for the intended use. Regarding the intended use of the claimed invention for pallet wooden board securement, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 13, 14, 17, 18, 20, 28 and 29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,758,018 in view of Ginnow (5,673,629). The Patent No. 6,758,018 discloses all the limitations of the claims except for a plurality of spaced bottom wooden boards, a plurality of spaced middle wooden boards and a plurality of top wooden boards and the nails for securing the plurality of

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boards together to form a pallet. Ginnow teaches a wooden pallet (21) comprising a plurality of spaced bottom wooden boards (23), a plurality of spaced middle wooden boards (20) and a plurality of top wooden boards (23) and a plurality of nails (34) for securing the plurality of boards together to form a pallet. It would have been obvious to one having ordinary skill in the art in view of Ginnow to modify the Patent No. 6,758,018 so the plurality nails are used for securing a plurality of boards together to form a wooden pallet for better supporting articles on the pallet. Claims 28-29 are drawn to the obvious method of using the package of the Patent No. 6,758,018 as modified.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (571) 272-4552. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc.; requests for copies of such papers should be directed to Ms. Marilyn Watts at (571) 272-4398.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 306-5648. Facsimile correspondence for this application should be sent to (703) 872-9306 for Formal papers and After Final communications.

lkb  
January 14, 2005



Luan K. Bui  
Primary Examiner